

### **REMARKS**

Claims 1-25 are pending in the present application. Claim 12 has been amended for editorial purposes. Claims 24 and 25 have been added. Support for the amendments can be found throughout the entire original disclosure and the original drawings. No new matter has been added and entry of the amendments is respectfully requested.

Applicant thanks the Examiner for withdrawing prior claim rejections in view of the Geerlings reference alone.

#### **Claim Rejections under 35 U.S.C. § 101**

The Examiner rejected claims 1-19 under 35 U.S.C. § 101 based on the Supreme Court precedent and recent Federal Circuit decisions. The Examiner alleged that the method steps of the pending claims are not tied to another statutory class and can be performed without the use of a particular apparatus. The Examiner concluded that the steps in the claims may be performed within the human mind.

More specifically, the Examiner asserted that the Office's guidance to examiners is that a § 101 process must be tied to another statutory class (such as a particular apparatus) or transform underlying subject matter (such as an article or materials) to a different state or thing.

Applicant respectfully traverses this rejection as discussed below. First, Applicant points out to the Examiner that the method claims do not contain all steps that can be performed within the human mind. Independent claim 1 recites the step of "automatically updating an electronic schedule with a least one task" (emphasis added). Independent

claim 17 recites “developing electronically at least one recommended action item” (emphasis added). Independent claim 20 recites “apparatus that electronically and statistically analyzes,” “apparatus that electronically develops at least one recommended action item” and “apparatus that electronically performs a task” (emphasis added).

Furthermore, the preambles of the method claims recite “A computer-implemented method of updating an electronic schedule” or “A computer-implemented method of assigning and performing task...” (emphasis added) which must be given weight in method claims.

Thus, the claims require an electronic apparatus which clearly makes the claims 1) tied to another statutory class (electronic apparatus), and 2) transform underlying subject matter (the electronic apparatus) to a different state or thing.

For the forgoing reasons, withdrawal and reconsideration of this rejection are respectfully requested.

#### Claim Rejections under 35 U.S.C. § 103

The Examiner rejected claims 1-8, 11-15 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Stack (U.S. Patent No. 6,782,370, hereinafter as “Stack”), in view of Geerlings (U.S. Patent No. 5,956,693, hereinafter as “Geerlings”).

Regarding claim 1, the Examiner asserted that the limitations of “statistically analyzing a collection of data ... including at least one non-purchaser” and “wherein at least one of said at least one non-purchaser is other than said current customer and past purchasers” are disclosed in Stack at column 1, lines 43-67. The Examiner further admitted

that Stack does not teach the limitation of “automatically updating an electronic schedule with at least one task representing the at least one recommended action item,” but alleged that Geerlings teaches this limitation.

Applicant respectfully traverses these claims rejections (as further discussed below) by arguing that Stack does not teach the limitations of “including at least one non-purchaser” and Geerlings does not teach the limitation of “automatically updating an electronic schedule.”

Applicant repeats the text of the cited passage (column 1, lines 43-67) below:

“A method for recommending goods or services is provided which allows the user of a computer system connected to a distributed network such as the Internet to receive recommendations of goods or services of potential interest based on a particular good or service selected by the user and previous customer buying history. The previous customer buying history is assembled by passively tracking and retaining or storing all purchasing decisions by previous customers.

The user first selects a particular good or service he may be interested in obtaining. This selection is treated as filter data input to a host computers' data processor. The data processor then compares this input data with a customer activity history database to determine if there are any possible goods or services that can be recommended to the user. If there are possible recommendations the user can choose to have those goods or services recommended to him by the system. The data processor then utilizes the filter data input and the customer history database to determine all of the customers who have purchased the particular good or service selected by the user and all the goods or services those customers-have purchased. The goods or services purchased in common by this group of customers are returned as filtered output data and displayed to the user as recommended goods or services” (emphasis added).

Applicant submits that this cited passage explains at best that Stack's system recommends goods or services to a current customer based on the customer's selection of

particular goods and a previous customer's activity history relating to the particular goods and all of the previous customers who have purchased the goods. However, claim 1 requires "at least one non-purchaser" interacting with the cited system who is "other than current customers and past purchasers."

The Examiner further asserted that "[w]hile Stack teaches generating recommendations, the reference fails to explicitly teach automatically updating an electronic schedule ... Geerlings teaches this feature (column 4, line 58 – column 5, line 5 ...) ... It would have been obvious ... to include in the recommendation system of Stack the scheduling of communications regarding the recommendations as taught by Geerlings since the claimed invention is merely a combination of old elements, ...and one of ordinary skill in the art would have recognized that the results of the combination were predictable."

Applicant repeats the text of the cited passages of Geerlings below:

At any rate, the strategy database 21 holds a set of plan outlines/working programs 53 (FIG. 4a) formulated by the merchant for various desired customer communications. A plan outline/working program 53 is defined as a singular communication with one or more customers or prospective customers. Working programs 53 may be combined into campaigns consisting of merchant-defined consecutive communications. Each plan outline/working program 53 identifies (1) the type of customer to whom the communication is to be sent (i.e., the target customer profile), (2) the contents of the communication, (3) the date(s) or timing of when the communication is to be sent, (4) the desired communication channel (i.e., mail, E-mail, facsimile, Internet, etc.) to be used, and (5) a destination (i.e., mail house, telemarketer, the merchant company or customer himself).

Applicant submits that these passages describe at best a strategy database holding a set of plan outlines/working programs formulated by the seller for customer

communications. Thus, these passages do not teach anything about the limitation of “automatically updating an electronic schedule.” Thus, Geerlings does not cure the deficiencies of Stack.

For the foregoing reasons, independent claims 1 and 17 are patentably distinguishable over Stack, Geerlings, or any reasonable combination thereof. If these independent claims are patentable, all claims dependent therefrom should be patentable. Therefore, withdrawal and reconsideration of this claim rejection are respectfully requested.

The Examiner further rejected claims 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Geerlings.

Regarding claim 9, the Examiner asserted that “Stack, in combination of Geerlings, teaches scheduling desired communication (mail, email, internet, fax, etc.) and the date or timing of when the communication is to be sent based on the product purchased (Geerlings, column 4, line 58 – column 5, line 5), but does not explicitly teach automatically rescheduling the task if it is not performed as scheduled.” The Examiner further asserted that Geerlings teaches generating trigger statements wherein a criterion is set that triggers an action, i.e., send a communication after a predetermined amount of time.

However, the Examiner failed to point out any passages or paragraphs teaching a trigger statement triggering an action of sending a communication to a prospective customer as asserted by the Examiner. Applicant submits that Geerlings teaches at best a trigger unit forming a working statement or trigger as follows:

“Each trigger unit 51 is joined together to form a working statement or "trigger" 49 using conjunctions AND, OR, NOT, as discussed below in FIG. 4d. For example, the trigger/working statement "(purchase frequency=1) AND (today-date last purchase>60 days)" specifies customers who have made only a single purchase more than two months ago, as the target customer group for the respective communication” (column 5, lines 12-23 of Geerlings).

As described in the above passages, Geerling’s trigger statement has something to do with categorizing customer groups, but it has nothing to do with the claimed limitation of “automatically rescheduling the task.” Thus, claim 9 is not obvious over Geerlings.

Regarding claim 10, the Examiner asserted that Geerlings teaches “generating trigger statements.” Applicant respectfully traverses this claim rejection on the same basis discussed in claim 9.

Applicant further submits that with respect to claims 9 and 10, the Examiner takes “official notice” that it would have been obvious to generate a trigger wherein if a communication is not sent as scheduled, i.e., a network error, the communication then would be rescheduled to be sent later. Applicant respectfully challenges this official notice and asks the Examiner to provide evidence such as a teaching that the Examiner alleged to be known in the art.

Thus, claims 9 and 10 are not obvious over Geerlings and reconsideration and withdrawal of these claim rejections are respectfully requested.

#### Claim Rejections under 35 U.S.C. § 102

The Examiner rejected claims 17-20, 22 and 23 under 35 U.S.C. § 102 (a and e) as being anticipated by Stack.

In addition to all of the above arguments, Applicant respectfully traverses these claim rejections by specifically arguing that Stack does not teach “at least one non-purchaser” as discussed in the rejection of claim 1 and that Stack does not teach the limitation of “performing a task that corresponds to the at least one recommended action item.”

The Examiner asserted that “performing a task” is disclosed in columns 3 and 4 of Stack. As the Examiner indicated, these columns describe how books are recommended to a customer, but they do not teach anything pertaining to the limitation of “performing a task.” More specifically, the passages do not relate to the tasks as recited in dependent claims 18 and 19.

For the foregoing reasons, Applicant submits that independent claims 17 and 20 requiring “at least one non-purchaser” and “performing a task” and their dependent claims are not anticipated by Stack and all of these rejected claims should be allowed. Thus, reconsideration and withdrawal of this rejection are respectfully requested.

Additionally, Applicant added dependent claims 24 and 25 depending on claims 17 and 20 respectively requiring the feature corresponding to the tasks as described and recited in claim 12 which depends from independent claim 1.

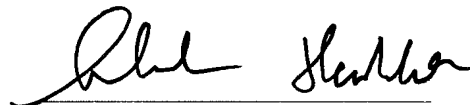
In addition to the above-suggested amendment, regarding claim 12, Applicant amended the claim by replacing the claim language “consisting of” with “comprising at least one of” so as to make it an open-ended limitation.

Accordingly, reconsideration of the outstanding Office Action and allowance of the

present application and all the claims therein are respectfully requested and now believed to be appropriate.

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this reply, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Respectfully submitted,  
Brent MAGOUIRK

A handwritten signature in black ink, appearing to read 'Abraham HersHKovitz', written over a horizontal line.

Abraham HersHKovitz  
Reg. No. 45,294

Dinh X. Nguyen  
Reg. No. 54,923

Jae Youn Kim  
L0485

November 20, 2008  
HERSHKOVITZ & ASSOCIATES, LLC  
2845 DUKE STREET  
ALEXANDRIA, VA 22314

TEL: (703) 370-4800  
FAX: (703) 370-4809